

Application No.: 10/083,727

RD-28645-1

Amendment dated: February 23, 2004

Reply to Office Action of November 21, 2003

REMARKS/ARGUMENTS

This case has been carefully reviewed in light of the Office Action dated November 21, 2003, wherein claims 18-31, 41-54 and 59-71 were withdrawn as being drawn to a non-elected invention; and claims 1-17, 32-40 and 55-58 were rejected. In this response the Applicants respectfully traverse the rejection of elected claims 1-17, 32-40 and 55-58 and urge that these and withdrawn claims 18-31, 41-54 and 59-71 recite patentable subject matter over the prior art. In addition, claim 14 was objected to due to an informality consisting of a missing comma. In response to the objection raised to claim 14, the Applicants request that the Examiner's objection be withdrawn as this informality will be corrected in a final plenary review of the application for such grammatical errors following allowance.

Claims 1-17, 32-40 and 50-58 were rejected under 35 U.S.C. 112, second paragraph. To each of the objections made by the Examiner in subsections a-m of section 4 of the Office Action, the Applicants urge that the language employed falls well within the bounds of current claim usage with respect to both antecedent basis and overall claim precision and clarity. The Applicants therefore respectfully request that the rejection of claims 1-17, 32-40 and 50-58 under 35 U.S.C. 112, second paragraph be withdrawn.

Claims 1-3, 5-6, 13-17, 32-37, 39-40 and 55-58 were rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Walt et al. (U.S. Patent No. 6,327,410). The Applicants' originally filed claim 1, upon which each of claims 2, 3, 5-6, 13-17, 32-37, 39-40 and 55-58 ultimately depends, recites the following:

A method for the generation and screening of three dimensional arrays comprising:

depositing a plurality of samples onto at least one substrate at discrete and defined positions in a three dimensional format such that each sample is isolated by the substrate from the other samples, and wherein each sample is defined by its (x, y, and z) coordinate to generate a three dimensional array of samples;

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collecting analytical data from the sample array, wherein the analytical data is at least partially defined by its (x, y, and z) coordinate within the sample array;

correlating the analytical data collected from the array to the position of samples within the array; and

analyzing the analytical data for a parameter of interest.

The limitation "wherein each sample is defined by its (x, y, and z) coordinate," given its ordinary meaning, requires that each sample be uniquely defined by its (x, y, and z) coordinate. Paragraph 45 of the instant Application makes clear that the (x, y, and z) coordinate referred to is understood in conventional mathematical terminology. Thus, in the instant invention, each sample in the three dimensional array is defined by its position in space. The Examiner suggests that the "size of the microsphere" or the "presence or the absence of a bead" may serve as a surrogate for the "z" spatial coordinate recited by Applicants' claim 1. The Applicants maintain that their claimed invention is fundamentally different from that disclosed by Walt et al. for precisely this reason. It is the position in space as described by a sample's (x, y, and z) coordinate which defines the sample, and it is this "definition" which renders the method of the instant invention useful in such applications as the performance testing of materials. The limitation "wherein each sample is defined by its (x, y, and z) coordinate" is material and is neither disclosed nor suggested by the Walt reference. Each of the remaining claims 2, 3, 5-6, 13-17, 32-37, 39-40 and 55-58 depends ultimately from claim 1. Thus, the Applicants urge that because claim 1 recites patentable subject matter for the reasons detailed herein, dependent claims 2, 3, 5-6, 13-17, 32-37, 39-40 and 55-58 necessarily recite patentable subject matter as well. For these reasons the Applicants respectfully request that the rejection of claims 1-3, 5-6, 13-17, 32-37, 39-40 and 55-58 under 35 U.S.C. 102(a) and (e) as being anticipated by Walt et al. be withdrawn.

Claims 4, 7-12 and 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over Walt et al. (U.S. Patent No. 6,327,410) in view of Chen et al. (U.S. Patent No. 6,638,760). Rejected claims 4, 7-12 and 38 depend from claim 1 which the Applicants

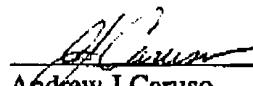
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strongly urge recites patentable subject matter for the reasons cited above. Since claim 1 recites allowable subject matter, it follows that dependent claims 4, 7-12 and 38 likewise recite patentable subject matter. For these reasons the Applicants respectfully request that the rejection of claims 4, 7-12 and 38 under 35 U.S.C. 103(a) as being unpatentable over Walt et al. in view of Chen et al. be withdrawn.

In view of the foregoing, the Applicants respectfully request reconsideration and prompt allowance of claims 1-17, 32-40 and 55-58. Should the Examiner believe that anything further is needed to place the application in even better condition for allowance, the Examiner is requested to contact Applicants' undersigned representative at the telephone number below.

Respectfully submitted,



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